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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,709	01/18/2001	Jukka V. Jokinen	4925-75	7582

7590 11/28/2006

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EXAMINER

JANVIER, JEAN D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 11/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/764,709

Applicant(s)

JOKINEN ET AL.

Examiner

Jean Janvier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 18 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Re-open Prosecution

In view of the Appeal Brief filed on 10/18/06 PROSECUTION IS HEREBY REOPENED as set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

Response To Applicant's Arguments

First, Applicant's arguments with respect to claims 1, 5, 17, 21 and 25 have been considered but are moot in view of the new ground(s) of rejection.

Second, in general, regarding claims 5 and 25 and contrary to the Applicant's remarks, **Buss discloses sending a targeted advertising message to a plurality of qualified mobile users based on the users' purchase habits or history (criterion) when the mobile users are within a geographic location proximate to a local store selling, for example, a product featured in the advertising message. Here, the advertising message content is specifically generated and targeted at the qualified mobile users in accordance with their purchase**

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habits, stored in a database, wherein the advertising message is selected and presented to the users when they are in a location of interest. Since, technically speaking, the users' purchase habits (purchase history or criterion to display an ad to a mobile user) are stored in a database and the targeted advertising message content is specifically directed to the qualified mobile users' attention, then the system is said to be operable to present to at least one user from a plurality of users targeted advertising content dynamically generated or generated in real-time based on the user's profile (such that if the number of qualified users is equal to ten, then an advertising message with ten uniquely targeted content will be generated or presented to the qualified users; in other, the content of the advertising message is dynamically/specifically generated based on the number of users).

DETAILED ACTION

Specification

General Comments

Claims 1, 17 and 21 recite "selecting at least one of a plurality of mobile terminal users, wherein the at least one selected mobile terminal user matches the at least one defined criterion..." and "defining a value of a dynamically generated promotional offer of the advertising message based on the number of the at least one of the mobile terminal users selected". Here, since at least one user from a plurality of users maybe selected to receive the promotional offer, then the value of the promotional offer will be generated in real-time for only one single user or the at least one selected user (i.e. based on the number

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of users selected, which is one). In other words, one single user maybe selected to receive the promotional offer having a specific value generated for the single user (or based on the number of users selected, which is one in this case). Here, the value of the promotional offer is not divided among a plurality of users, as the Applicant intends to claim.

Further, claims 5 and 25 recite “an advertising message to be sent to the selected at least one of a plurality of mobile terminals including content to be sent to the at least one of a plurality of mobile terminals, the content of the advertising message being dynamically generated based on a number of mobile terminals selected using the at least one specific criterion....”. Here, and as described above, only one single user from a plurality of users maybe selected to receive the targeted advertising message uniquely generated for the single user. Moreover, and broadly interpreted, “dynamically generating a content of an advertising message based on a number of recipients” simply means that “the content is uniquely directed to the user’s attention based on some criteria”.

Additionally, the claims or at least the independent claims will be rejected as discussed above.

Finally, throughout the claimed invention, “user information”, broadly considered, can be interpreted as - -user’s current location- - instead of profile information.

Claim Objections

Claims 8, 9 and 21-24 are objected to because of the following informalities:

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Concerning claim 21, after the first instance of “a promotional offer” as recited in lines 12-13, any subsequent recitation of “a promotional offer” therein should be replaced with --the promotional offer--.

Concerning claims 8 and 9, in “The method of claim 5, wherein the step of obtaining user location information comprises.....”, the Examiner notes that that claim 5 never recites “a step of obtaining user location...”.

Throughout the claimed invention, after “...at least one of...”, claim elements are treated in the alternative. For example, in claim 8, “, wherein the step of obtaining user information comprises obtaining at least one of user profile information and user location” should be --, wherein the step of obtaining user information comprises obtaining at least one of user profile information or user location--.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 17-20, 21-24, 10, 12-14, 29, 31-33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buss et al. (hereinafter Buss), US Patent 5, 539, 395A in view of Bandera, US Patent 6, 332, 127.

As per claims 1-3, 17-19 and 21-23, Buss discloses a location dependent information receiving system and method for displaying over a paging system location-oriented messages, such advertisements, on a plurality of users' paging device (cellular telephone) screens if the users or the users' paging devices are within a targeted location, proximate to a local store or store chain selling a product featured in at least one transmitted message or advertising message, matching a location identifier (criterion) as specified by the advertiser of the at least one (transmitted location specific) message or advertising message. In other words, an advertising message for a local store or store chain may be broadcast only to customers being in the vicinity of the local store(s) or a single transmission via the paging system of the advertising message or the incoming signal may be received by a plurality of paging devices located in the proximity (within an area of coverage) of the local stores (generating an advertising message to be transmitted in a single transmission to a number of mobile units).

In another embodiment, the incoming signal or advertising message may only be broadcast to paging devices if the incoming signal location identifier matches the current location of at least one paging device and an address marker or identifier embedded in the message matches the paging device address of the receiving paging device. The latter helps reduce the transmission of unwanted messages to the users of the devices or helps reduce the amount of sorting or going through unwanted information transmitted to the users of the paging

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devices via the paging system. Specifically addressing the incoming signal to particular devices located in the vicinity of a location of interest allows the system to identify the users associated with the paging devices and wherein **the users' profile, such as purchasing habit**, can be used to transmit targeted messages to the users when the users' presence is detected, via the uniquely addressable paging devices, within an area of coverage or area of interest. Once again, the transmission of the targeted information or advertising message to the users reduces the amount of information that the users sort through in order to find information relevant to them since the information is specific to the users and related to the vicinity in which the users are or intend to be. It is further recognized in the Buss's system that the advertiser will be charged for distributing his advertising message to the targeted or qualified users contingent upon a prior business agreement (broadly speaking, the advertiser will pay a fee for distributing advertisements to qualified mobile users over the network whether or not the advertisements are transmitted along with other data such coupon information).

In general, **Buss discloses sending a targeted advertising message to a plurality of qualified mobile users based on the users' purchase habits or history (criterion) when the mobile users are within a geographic location proximate to a local store selling, for example, a product featured in the advertising message. Here, the advertising message content is specifically generated and targeted at the qualified mobile users in accordance with their purchase habits, stored in a database, wherein the advertising message is selected and presented to the users when they are in a location of interest. Since, technically speaking, the users' purchase habits (purchase history or criterion to display an ad to a mobile user) are stored in a database and the targeted advertising message content is specifically directed**

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to the qualified mobile users' attention, then the system is said to be operable to present to at least one user from a plurality of users targeted advertising content dynamically generated or generated in real-time based on the user's profile (such that if the number of qualified users is equal to ten, then an advertising message with ten uniquely targeted content will be generated or presented to the qualified users; in other words, the content of the advertising message is dynamically/specifically generated based on the number of users).

(See abstract; col. 1: 39-48; col. 2: 24-34; col. 3: 58 to col. 4: 46; col. 5: 36-57; col. 5: 64 to col. 6: 17).

As per claims 1, 17, 21, 4, 20, 24, 10, 12-14, 29, 11 and 30-34, Buss does not expressly disclose the steps of associating with the advertising message transmitted to the selected mobile terminals a promotional offer or an electronic coupon, defining a monetary value related to the promotional offer based on the number of mobile terminal users selected (**which is one here as shown above**), validating and tracking the use of the electronic coupon or promotional offer after the coupon has been redeemed by transmitting the coupon data from the mobile terminals to a store POS system.

However, Bandera discloses a method, system and/or computer program product for providing time and location specific advertising object and other information object via a communication means 25 of fig. 1 to a user or customer using a portable terminal or mobile web client 21 of fig. 1, having a display or screen, an input device and so forth, connected to the communication means 25 wherein advertising object 32 and other information 34 are returned to

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the user via a web page 26 in response to the accessing a web site by the user for information and wherein an object oriented programming language such as JAVA (software) or more specifically a JAVA Virtual Machine or JVM is running on the portable terminal so as to allow JAVA Applets (programs written in JAVA) to run on the portable terminal, thereby selecting advertisements to be displayed on the screen of the portable terminal based on the present location, and/or time of the day, associated with the mobile web client or portable terminal used by the user. (See abstract; figs. 1 and 6; col. 2: 33 to col. 3: 41; col. 5: 26 to col. 6: 24; col. 9: 29-41).

In another embodiment, a targeted advertisement object can be selected and presented to at least one mobile user based on the current location of the mobile client and the time of the day the user's request is received by the web server **(the advertising content is generated in real-time based on the number of selected mobile client recipients, which is one here)**. For example, an advertisement object related to bagels may be selected by the web server and displayed within the requested web page along with requested information when the web page request is received between the hours of 6:00 AM-9:00AM, wherein the bagels are sold at a store located in the same area as the user of the Web client. Indeed, an electronic coupon associated with bagels sold at the advertiser's local store is transmitted to the user's mobile client (Handheld device, PDA, cellular phone, etc.) for reading the advertising message, wherein the coupon is stored in the user's mobile device before it is being redeemed at the local store **(the value of the coupon is defined or calculated based on the number of mobile client recipients, which is one here)**. Data associated with the electronic coupon include an expiration date, a serial number, encrypted information (location identifier and time identifier), wherein the

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encrypted information is used to prevent the user from manually and programmatically modifying the contents of the stored coupon, especially the coupon value. The user can then take the mobile client to the advertiser's local store POS where during a synchronization process between the mobile client and the POS system, conducted via an IR link, wireless connection, wireline connection, RF link, Bluetooth radio standard connection or a serial cable, the electronic coupon data, including the encrypted information, are transferred to the POS system, which decrypts the received encrypted coupon information to validate the location information, the time of day information and the value of the coupon to thereby making sure that the coupon data were not tampered with before effecting a redemption by applying a price reduction to the user's or customer's order when the required product is purchased. Further, a network registry of coupon serial numbers is utilized to track the use of the coupon to thereby reduce the risk of a coupon being used more than once. At the conclusion of the transaction or redemption, the network registry of coupon serial numbers is updated to reflect the redemption of the said electronic coupon (tracking the use of the coupon). **It is herein understood that the coupon data, including the related product or service involved, coupon value, etc., are generated based on the user's current location (first criterion) and the time of day (second criterion)** (col. 7: 41-52; col. 7: 56 to col. 9: 42).

In short, **Bandera discloses sending a targeted advertising message, including a time- and-location sensitive coupon or promotional offer having an associated value, to one or more mobile users based on their present location and time of the day (criteria) when the mobile users are within a geographic location proximate to a local store selling, for example, a product featured in the advertising message. Here, the advertising message**

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content, including the said coupon, is specifically generated and targeted at the qualified mobile users in accordance with their present location and the time of day, wherein the advertising message including the coupon is selected and presented to the users when they are in a location of interest. Here, the targeted advertising message content, including the associated coupon, is specifically directed to the qualified mobile users' attention, and hence, the system is said to be operable to present to at least one user from a plurality of users targeted advertising content, including a coupon, dynamically generated or generated in real-time in response to a user's request and based on the user's current location and time of day (such that if the number of qualified users is equal to ten, then an advertising message with ten uniquely targeted content will be generated or presented to the qualified users; in other words, the content of the advertising message is dynamically/specifically generated based on the number of users).

See col. 2: 11-23; col. 4: 46-60; col. 6: 42 to col. 7: 52; figs. 6, 8 and 9A-9B.

See col. 2: 11-23; col. 4: 46-60; col. 6: 42 to col. 7: 52; figs. 6, 8 and 9A-9B.

In addition, it is common practice to print a serial number, a product UPC code, a user's specific code, a redemption location, a coupon value, an expiration date, etc., on a coupon. Hence, the type of information that needs to be printed on a coupon varies from one coupon distributor to another and hence, it is a matter of choice. It is also customary in the art for a product manufacturer, a product distributor, a coupon issuer or an advertiser providing one or more coupons, related to one or more specific products, to qualified users during a promotional period or advertising campaign to limit the number of coupons that can be distributed or issued

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to the users by tracking the coupon usage through redemption data or reports collected from associated retailers (See the Golden's Patent cited as prior art by the Applicant and Lemon's Patent in the conclusion section).

Therefore, an ordinary skilled artisan would have been motivated at the time of the invention to incorporate the location and time sensitive system of Bandera into the Buss's system so as to transmit an advertising message along with an electronic coupon from an advertiser to at least one of a plurality of qualified users of mobile terminals or paging devices if the at least one user is within a coverage area or area of interest (where the advertiser's local store is located) at a particular time of the day, wherein the electronic coupon data, including expiration date, coupon serial number and encrypted information representative of the local store location or redemption site, the time of the day and the value of the coupon (defined based on the number of **recipients, which is one here**), are stored in the user's mobile terminal for later retrieval and usage, wherein the value of the coupon is set or defined in accordance with the number of targeted users (**which is one here**) and a predetermined budget set aside by the advertiser to run the promotional campaign and wherein the coupon is validated during a redemption process via the mobile devices and tracked afterwards to prevent fraudulent activities, thereby rendering the advertising or message distribution system more flexible and more dynamic while encouraging the user of a cell phone, paging device or mobile client, whose presence is detected via his mobile terminal in the vicinity of the advertiser's local store, to read an advertising message related to a product or service sold or available at the local store and transmitted on behalf of the advertiser from the paging system and displayed on the screen of the user's s mobile device by providing an

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electronic coupon, related to the transmitted advertisement, to the user for viewing the transmitted advertising message and wherein the user uses the electronic coupon during a redemption or synchronization process, between the mobile client or mobile terminal and the local store POS system, conducted via an IR link, wireless connection, wireline connection, RF link, BlueTooth radio standard connection or a serial cable, where the electronic coupon data, including the encrypted information, are transferred to the POS system, which decrypts the received encrypted coupon information to validate the location information, the time of day information and the value of the coupon to make sure that the coupon data were not tampered with before effecting a redemption by applying a price reduction, equal to the value of the coupon to the user's or customer's order when the required product or service featured in the advertising message is purchased and at the conclusion of the transaction or redemption, a network registry of coupon serial numbers is updated to reflect the redemption of the said electronic coupon by flagging or deleting the redeemed coupon serial number from the registry in order to reduce the risk of a coupon being used more than once.

Claims 1-4, 27 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bandera, US Patent 6, 332, 127 in view of Buss et al. (hereinafter Buss), US Patent 5, 539, 395A.

As per claims 1-4 and 17-20, Bandera discloses a method, system and/or computer program product for providing time and location specific advertising object and other information object via a communication means 25 of fig. 1 to a user or customer using a portable

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terminal or mobile web client 21 of fig. 1, having a display or screen, an input device and so forth, connected to the communication means 25 wherein advertising object 32 and other information 34 are returned to the user via a web page 26 in response to the accessing a web site by the user for information and wherein an object oriented programming language such as JAVA (software) or more specifically a JAVA Virtual Machine or JVM is running on the portable terminal so as to allow JAVA Applets (programs written in JAVA) to run on the portable terminal, thereby selecting advertisements to be displayed on the screen of the portable terminal based on the present location, and/or time of the day, associated with the mobile web client or portable terminal used by the user. (See abstract; figs. 1 and 6; col. 2: 33 to col. 3: 41; col. 5: 26 to col. 6: 24; col. 9: 29-41).

In another embodiment, a targeted advertisement object can be selected and presented to at least one mobile user based on the current location of the mobile client and the time of the day the user's request is received by the web server (**the advertising content is generated in real-time based on the number of selected mobile client recipients, which is one here**). For example, an advertisement object related to bagels may be selected by the web server and displayed within the requested web page along with requested information when the web page request is received between the hours of 6:00 AM-9:00AM, wherein the bagels are sold at a store located in the same area as the user of the Web client. Indeed, an electronic coupon associated with bagels sold at the advertiser's local store is transmitted to the user's mobile client (Handheld device, PDA, cellular phone, etc.) for reading the advertising message, wherein the coupon is stored in the user's mobile device before it is being redeemed at the local store (**the value of the coupon is defined or calculated based on the number of mobile client**

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recipients, which is one here). Data associated with the electronic coupon include an expiration date, a serial number, encrypted information (location identifier and time identifier), wherein the encrypted information is used to prevent the user from manually and programmatically modifying the contents of the stored coupon, especially the coupon value. The user can then take the mobile client to the advertiser's local store POS where during a synchronization process between the mobile client and the POS system, conducted via an IR link, wireless connection, wireline connection, RF link, BlueTooth radio standard connection or a serial cable, the electronic coupon data, including the encrypted information, are transferred to the POS system, which decrypts the received encrypted coupon information to validate the location information, the time of day information and the value of the coupon to thereby making sure that the coupon data were not tampered with before effecting a redemption by applying a price reduction to the user's or customer's order when the required product is purchased. Further, a network registry of coupon serial numbers is utilized **to track** the use of the coupon to thereby reduce the risk of a coupon being used more than once. At the conclusion of the transaction or redemption, the network registry of coupon serial numbers is updated to reflect the redemption of the said electronic coupon (tracking the use of the coupon). **It is herein understood that the coupon data, including the related product or service involved, coupon value, etc., are generated based on the user's current location (first criterion) and the time of day (second criterion)** (col. 7: 41-52; col. 7: 56 to col. 9: 42).

\In general, Bandera **discloses sending a targeted advertising message, including a time-and-location sensitive coupon or promotional offer having an associated value, to one or more mobile users based on their present location and time of the day (criteria) when**

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the mobile users are within a geographic location proximate to a local store selling, for example, a product featured in the advertising message. Here, the advertising message content, including the said coupon, is specifically generated and targeted at the qualified mobile users in accordance with their present location and the time of day, wherein the advertising message including the coupon is selected and presented to the users when they are in a location of interest. Here, the targeted advertising message content, including the associated coupon, is specifically directed to the qualified mobile users' attention, and hence, the system is said to be operable to present to at least one user from a plurality of users targeted advertising content, including a coupon, dynamically generated or generated in real-time in response to a user's request and based on the user's current location and time of day (such that if the number of qualified users is equal to ten, then an advertising message with ten uniquely targeted content will be generated or presented to the qualified users; in other words, the content of the advertising message is dynamically/specifically generated based on the number of users).

See col. 2: 11-23; col. 4: 46-60; col. 6: 42 to col. 7: 52; figs. 6, 8 and 9A-9B.

As per claims 1, 17 and 27, Bandera do not expressly disclose storing one more users' profile information in a server database and using the profile information to select one mobile user from a plurality of mobile users or mobile terminals.

However, Buss discloses a location dependent information receiving system and method for displaying over a paging system location-oriented messages, such advertisements, on a plurality of users' paging device (cellular telephone) screens if the users or the users' paging

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devices are within a targeted location, proximate to a local store or store chain selling a product featured in at least one transmitted message or advertising message, matching a location identifier (criterion) as specified by the advertiser of the at least one (transmitted location specific) message or advertising message. In other words, an advertising message for a local store or store chain may be broadcast only to customers being in the vicinity of the local store(s) or a single transmission via the paging system of the advertising message or the incoming signal may be received by a plurality of paging devices located in the proximity (within an area of coverage) of the local stores (generating an advertising message to be transmitted in a single transmission to a number of mobile units).

In another embodiment, the incoming signal or advertising message may only be broadcast to paging devices if the incoming signal location identifier matches the current location of at least one paging device and an address marker or identifier embedded in the message matches the paging device address of the receiving paging device. The latter helps reduce the transmission of unwanted messages to the users of the devices or helps reduce the amount of sorting or going through unwanted information transmitted to the users of the paging devices via the paging system. Specifically addressing the incoming signal to particular devices located in the vicinity of a location of interest allows the system to identify the users associated with the paging devices and wherein **the users' profile, such as purchasing habit**, can be used to transmit targeted messages to the users when the users' presence is detected, via the uniquely addressable paging devices, within an area of coverage or area of interest. Once again, the transmission of the targeted information or advertising message to the users reduces the amount of information that the users sort through in order to find information relevant to them since the

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information is specific to the users and related to the vicinity in which the users are or intend to be. It is further recognized in the Buss's system that the advertiser will be charged for distributing his advertising message to the targeted or qualified users contingent upon a prior business agreement (broadly speaking, the advertiser will pay a fee for distributing advertisements to qualified mobile users over the network whether or not the advertisements are transmitted along with other data such coupon information).

In general, Buss discloses sending a targeted advertising message to a plurality of qualified mobile users based on the users' purchase habits or history (criterion) when the mobile users are within a geographic location proximate to a local store selling, for example, a product featured in the advertising message. Here, the advertising message content is specifically generated and targeted at the qualified mobile users in accordance with their purchase habits, stored in a database, wherein the advertising message is selected and presented to the users when they are in a location of interest. Since, technically speaking, the users' purchase habits (purchase history or criterion to display an ad to a mobile user) are stored in a database and the targeted advertising message content is specifically directed to the qualified mobile users' attention, then the system is said to be operable to present to at least one user from a plurality of users targeted advertising content dynamically generated or generated in real-time based on the user's profile (such that if the number of qualified users is equal to ten, then an advertising message with ten uniquely targeted content will be generated or presented to the qualified users; in other words, the content of the advertising message is dynamically/specifically generated based on the number of users).

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(See abstract; col. 1: 39-48; col. 2: 24-34; col. 3: 58 to col. 4: 46; col. 5: 36-57; col. 5: 64 to col. 6: 17).

Additionally, it is common practice in the art to present an advertising message to a user and/or to provide a coupon to a user based on the user's profile (See US Patents 6,321,208 to Barnett and 5,794,210 to Goldhaber).

Therefore, an ordinary skilled artisan would have been motivated at the time of the invention to incorporate the Buss's profile-based-system into the location-and-time sensitive system of Bandera so as to transmit an advertising message along with an electronic coupon from an advertiser to at least one of a plurality of qualified users of mobile terminals or paging devices if the at least one user is within a coverage area or area of interest (where the advertiser's local store is located) at a particular time of the day **and if the user's profile information, such as stored purchase habits, matches a desired profile information (selection criteria)**, wherein the electronic coupon data, including expiration date, coupon serial number and encrypted information representative of the local store location or redemption site, the time of the day and the value of the coupon (defined based on the number of **recipients, which is one here**), are stored in the user's mobile terminal for later retrieval and usage, wherein the value of the coupon is set or defined in accordance with the number of targeted users (**which is one here**) and a predetermined budget set aside by the advertiser to run the promotional campaign and wherein the coupon is validated during a redemption process via the mobile devices and tracked afterwards to prevent fraudulent activities, thereby rendering the advertising message and associated coupon (promotional offer), now targeted at the at least one user based on the location

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of the mobile device, time of day and the user's profile information (purchase habits), more appealing to the at least one user, wherein the coupon is redeemable on a product that the user has previously purchased or shown interest in, as read from the user's stored profile or purchase habits, and wherein the product is sold or made available at a local store proximate to the mobile device present location as detected by a GPS unit coupled to the mobile device and the time of day, while increasing the chance that the user will be more receptive to the advertising message and promotional offer or coupon and, as a result, will redeem the associated coupon on time and while augmenting the coupon redemption rate and the economic bottom line of the local store owner or advertiser resulting from an increase in sales related to purchases linked to the coupons.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 5, 6, 7, 8, 9, 15, 16 and 25-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Buss et al. (hereinafter Buss), US Patent 5, 539, 395A.

As per claims 5, 6, 7, 8, 9, 15, 16 and 25-28, Buss discloses a location dependent information receiving system and method for displaying over a paging system location-oriented messages, such advertisements, on a plurality of users' paging device (cellular telephone) screens

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if the users or the users' paging devices are within a targeted location, proximate to a local store or store chain selling a product featured in at least one transmitted message or advertising message, matching a location identifier (criterion) as specified by the advertiser of the at least one (transmitted location specific) message or advertising message. In other words, an advertising message for a local store or store chain may be broadcast only to customers being in the vicinity of the local store(s) or a single transmission via the paging system of the advertising message or the incoming signal may be received by a plurality of paging devices located in the proximity (within an area of coverage) of the local stores (generating a an advertising message to be transmitted in a single transmission to a number of mobile units).

In another embodiment, the incoming signal or advertising message may only be broadcast to paging devices if the incoming signal location identifier matches the current location of at least one paging device and an address marker or identifier embedded in the message matches the paging device address of the receiving paging device. The latter helps reduce the transmission of unwanted messages to the users of the devices or helps reduce the amount of sorting or going through unwanted information transmitted to the users of the paging devices via the paging system. Specifically addressing the incoming signal to particular devices located in the vicinity of a location of interest allows the system to identify the users associated with the paging devices and wherein the users' profile, such as purchasing habit, can be used to transmit targeted messages to the users when the users' presence is detected, via the uniquely addressable paging devices, within an area of coverage or area of interest. Once again, the transmission of the targeted information or advertising message to the users reduces the amount of information that the users sort through in order to find information relevant to them since the

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information is specific to the users and related to the vicinity in which the users are or intend to be.

In general, Buss discloses sending a targeted advertising message to a plurality of qualified mobile users based on the users' purchase habits or history (criterion) when the mobile users are within a geographic location proximate to a local store selling, for example, a product featured in the advertising message. Here, the advertising message content is specifically generated and targeted at the qualified mobile users in accordance with their purchase habits, stored in a database, wherein the advertising message is selected and presented to the users when they are in a location of interest. Since, technically speaking, the users' purchase habits (purchase history or criterion to display an ad to a mobile user) are stored in a database and the targeted advertising message content is specifically directed to the qualified mobile users' attention, then the system is said to be operable to present to at least one user from a plurality of users targeted advertising content dynamically generated or generated in real-time based on the user's profile (such that if the number of qualified users is equal to ten, then an advertising message with ten uniquely targeted content will be generated or presented to the qualified users; in other words, the content of the advertising message is dynamically/specifically generated based on the number of users).

(See abstract; col. 1: 39-48; col. 2: 24-34; col. 3: 58 to col. 4: 46; col. 5: 36-57; col. 5: 64 to col. 6: 17).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 5-16 and 21-24, 25, 26, 28-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Bandera, US Patent 6,332,127.

As per claims 5-16 and 21-24, 25, 26, 28-34, Bandera discloses a method, system and/or computer program product for providing time and location specific advertising object and other information object via a communication means 25 of fig. 1 to a user or customer using a portable terminal or mobile web client 21 of fig. 1, having a display or screen, an input device and so forth, connected to the communication means 25 wherein advertising object 32 and other information 34 are returned to the user via a web page 26 in response to the accessing a web site by the user for information and wherein an object oriented programming language such as JAVA

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(software) or more specifically a JAVA Virtual Machine or JVM is running on the portable terminal so as to allow JAVA Applets (programs written in JAVA) to run on the portable terminal, thereby selecting advertisements to be displayed on the screen of the portable terminal based on the present location, and/or time of the day, associated with the mobile web client or portable terminal used by the user. (See abstract; figs. 1 and 6; col. 2: 33 to col. 3: 41; col. 5: 26 to col. 6: 24; col. 9: 29-41).

In another embodiment, a targeted advertisement object can be selected and presented to at least one mobile user based on the current location of the mobile client and the time of the day the user's request is received by the web server (**the advertising content is generated in real-time based on the number of selected mobile client recipients, which is one here**). For example, an advertisement object related to bagels may be selected by the web server and displayed within the requested web page along with requested information when the web page request is received between the hours of 6:00 AM-9:00AM, wherein the bagels are sold at a store located in the same area as the user of the Web client. Indeed, an electronic coupon associated with bagels sold at the advertiser's local store is transmitted to the user's mobile client (Handheld device, PDA, cellular phone, etc.) for reading the advertising message, wherein the coupon is stored in the user's mobile device before it is being redeemed at the local store (**the value of the coupon is defined or calculated based on the number of mobile client recipients, which is one here**). Data associated with the electronic coupon include an expiration date, a serial number, encrypted information (location identifier and time identifier), wherein the encrypted information is used to prevent the user from manually and programmatically modifying the contents of the stored coupon, especially the coupon value. The user can then take

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the mobile client to the advertiser's local store POS where during a synchronization process between the mobile client and the POS system, conducted via an IR link, wireless connection, wireline connection, RF link, Bluetooth radio standard connection or a serial cable, the electronic coupon data, including the encrypted information, are transferred to the POS system, which decrypts the received encrypted coupon information to validate the location information, the time of day information and the value of the coupon to thereby making sure that the coupon data were not tampered with before effecting a redemption by applying a price reduction to the user's or customer's order when the required product is purchased. Further, a network registry of coupon serial numbers is utilized to track the use of the coupon to thereby reduce the risk of a coupon being used more than once. At the conclusion of the transaction or redemption, the network registry of coupon serial numbers is updated to reflect the redemption of the said electronic coupon (tracking the use of the coupon). **It is herein understood that the coupon data, including the related product or service involved, coupon value, etc., are generated based on the user's current location (first criterion) and the time of day (second criterion)** (col. 7: 41-52; col. 7: 56 to col. 9: 42).

\In general, Bandera discloses sending a targeted advertising message, including a time-and-location sensitive coupon or promotional offer having an associated value, to one or more mobile users based on their present location and time of the day (criteria) when the mobile users are within a geographic location proximate to a local store selling, for example, a product featured in the advertising message. Here, the advertising message content, including the said coupon, is specifically generated and targeted at the qualified mobile users in accordance with their present location and the time of day, wherein the

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advertising message including the coupon is selected and presented to the users when they are in a location of interest. Here, the targeted advertising message content, including the associated coupon, is specifically directed to the qualified mobile users' attention, and hence, the system is said to be operable to present to at least one user from a plurality of users targeted advertising content, including a coupon, dynamically generated or generated in real-time in response to a user's request and based on the user's current location and time of day (such that if the number of qualified users is equal to ten, then an advertising message with ten uniquely targeted content will be generated or presented to the qualified users; in other words, the content of the advertising message is dynamically/specifically generated based on the number of users).

See col. 2: 11-23; col. 4: 46-60; col. 6: 42 to col. 7: 52; figs. 6, 8 and 9A-9B.

Conclusion

Although the following references were not officially used in the Office Action, they were highly considered.

US Patent 4,674,041 to Lemon discloses a system having remotely located coupon printing stations installed in stores and capable of limiting the number of coupons printed in a given time period. Each coupon station has a display for indicating the available coupons, selection means to allow a consumer to choose the desired coupon and a coupon printer coupled to a station for printing the selected coupon. The system disables display of a particular coupon when a pre-selected coupon limit has been reached (col. 2: 16-19; col. 3: 39-54; col. 4: 47-51).

US Patent 6,647,269 to Hendrey teaches a method and system for analyzing a targeted advertisements delivered to a mobile unit, wherein location information of the mobile unit and a the profile (preferences) of the user of the mobile unit are used to generate a targeted advertisement for the user and wherein the location of the mobile unit and the user's preferences match a local business location and preferences. Upon detecting the presence of the mobile unit in the local business geographic area or radius (as covered by a base station), an advertisement, tailored to the user's psychographic profile, for the business is transmitted to the mobile unit. Subsequent to this transmission, the position of the user or the mobile unit is monitored or tracked to determine the effectiveness of the transmitted advertisement (verifying reception). If the user enters the business location or store and/or makes a timely purchase associated with an item featured in the advertisement and sold at the business store, then the advertisement is recorded or logged as being successful. Furthermore, if the user has not entered the store within a preset period of time subsequent to receiving the advertisement or moves away from the store, then the advertisement has failed. (See abstract; fig. 1-2; col. 1: 55 to col. 2: 40; col. 3: 18-23; col. 4: 28-45; col. 5: 13-25).

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Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (703) 308-6287). The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (703) 305- 8469.

For information on the status of your case, please call the help desk at (703) 308-1113.

Further, the following fax numbers can be used, if need be, by the Applicant(s):

After Final- 703-872-9327

Before Final -703-872-9326

Non-Official Draft- 703-746-7240

Customer Service- 703-872-9325

JDJ

11/18/04

Jean D. Janvier

Patent Examiner

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JEAN D. JANVIER
PRIMARY EXAMINER
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A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

Eric Stamber

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